

The opinion in support of the decision being entered today was **not** written for publication in a law journal and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTON NIJBOER, FOKKE JAGER and HENRY W. DINGLEY

Appeal No. 1999-0387
Application No. 08/590,278

ON BRIEF

Before FRANKFORT, NASE, and JENNIFER D. BAHR, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 20, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

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BACKGROUND

The appellants' invention relates to a record pad. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Johnsen 1976	3,945,870	Mar. 23,
Drake	EP 0 325 057 A2	July 26, 1989
Perriman et al. (Perriman)	EP 0 486 127 A1	May 20, 1992

Claims 1-4, 6, 7, 9, 10, 12, 16, 19 and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Drake.

Claims 1-7, 9-12, 16, 19 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Drake.

Claims 8, 12-14, 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Drake in view of Johnsen.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Drake in view of Perriman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 17, mailed July 9, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed March 31, 1998) and reply brief (Paper No. 18, filed September 8, 1998) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection over Drake

We sustain the rejection of claims 1-4, 6, 7, 10, 12, 16 and 20 under 35 U.S.C. § 102(b) as being anticipated by Drake, but not the rejection of claims 9 and 19.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claim 9 depends from claim 8. Since claim 8 was not rejected as being anticipated by Drake and the limitations of claim 8 are clearly not met by Drake, all the limitations of claim 9 are not met by Drake. Similarly, claim 19 depends from claim 17. Since claim 17 was not rejected as being anticipated by Drake and the limitations of claim 17 are clearly not met by Drake, all the limitations of claim 19 are not met by Drake. Accordingly, the decision of the examiner to reject claims 9 and 19 under 35 U.S.C. § 102(b) is reversed.

Drake discloses a record book or pad which is manufactured with record sheets 2 and removable sheets 1 disposed in pairs. An image transfer element is provided for transferring manuscript notes 7, 7a from sheet 1 to sheet 2 in a pair. Each removable sheet 1 has a line of weakness 5 whereby a portion 1a of that sheet can be torn from a spine part 3 of the book or pad. Drake teaches (column 3, lines 26-30) that each removable sheet may be sub-divided (for example, by cut lines or perforations) into two or more coplanar sheet portions each

having a line of weakness which permits that sheet portion to be torn from the spine part of the book or pad. Each portion 1a has on its underside surface a region 9 of low tack adhesive by which that portion can be attached temporarily to a receptive surface remote from the book. The low tack adhesive is preferably applied as a strip 8 with a width sufficient to extend from the spine part of each removable sheet 1, over the line of weakness 5, to provide the region 9 on the removable portion 1a. The sheets are bound together along the spine part 3 by a helical wire 4 which extends parallel to an edge of the stack. Drake provides that Figure 1 is a perspective view of the book showing a removable sheet portion of a removable sheet having three such portions positioned to be torn from the book and that Figure 2 shows an end view of the book and diagrammatically illustrates the structure of the record and removable sheets with the low tack adhesive.

The examiner's anticipation rejection is based on his view that the subject matter of claims 1-4, 6, 7, 10, 12, 16 and 20 is "readable" on Drake. The heart of this rejection is

the examiner's view that the claimed upper margin is "readable" on the edge portion of Drake's removable sheet 1 adjacent the spine part 3 where the sheets are bound together. The appellants disagree for the reasons set forth in the brief (pp. 5-8) and reply brief (pp. 1-2). In the appellants' view, the edge portion of Drake's removable sheet 1 adjacent the spine part 3 is not the upper margin of the sheet 1 during normal use since it is a side margin during normal use.

We agree with the examiner that the claimed upper margin is "readable" on the edge portion of Drake's removable sheet 1 adjacent the spine part 3 where the sheets are bound together. It is our view that the record pad of Drake (shown in Figures 1-2) has at least two "normal use" positions since Drake's record pad does not have any configuration (e.g., preprinted words on portions 1a of the removable sheets 1) dictating one "normal use" position.¹ The first "normal use" position of Drake's record pad is where the spine part 3 and helical wire

¹ In that regard, the manuscript notes 7, 7a shown in Figure 1 are indicia of the message notes to be written on the record pad.

4 are positioned on the left side. The second "normal use" position of Drake's record pad is where the spine part 3 and helical wire 4 are positioned on the top side.²

When Drake's record pad is in its second "normal use" position, claim 1 is readable on Drake as follows. A record pad (see Figures 1 and 2 of Drake) comprising: a plurality of sheet sets (see column 4, lines 27-30, of Drake), each sheet set comprising a paper top sheet having a top face and a bottom face (Drake's removable sheet 1), at least one underlying record bottom sheet (Drake's record sheet 2), and a transfer mechanism for transferring indicia imaged on said top sheet to an underlying said record sheet (see column 4, lines 30-45, of Drake); said top sheet comprising an upper margin, a lower margin substantially parallel to said upper margin, and first and second side margins substantially perpendicular to said upper and lower margins, said upper margin being at the upper portion of said top sheet during normal use of said top

² We note that it is well known in this art that the helical wire that bounds sheets of a book or pad together is normally positioned along either the top edge or the left edge.

sheet to enter indicia on said top sheet (see Figure 1 of Drake, the spine part 3 being located at the upper margin of the sheets 1 & 2); a securing edge margin of each sheet set of said plurality of sheet sets for connecting said sheet sets in a record pad (Drake's spine part 3); and a pattern of repositionable adhesive provided on each said top sheet bottom face adjacent to said upper margin and substantially parallel to said upper margin (Drake's strip 8 of low tack adhesive).

When Drake's record pad is in its second "normal use" position, claim 2 is readable on Drake as follows. A record pad as recited in claim 1 further comprising at least one line of weakness in each said top sheet extending substantially parallel to said upper margin dividing said top sheet into at least a first portion containing said upper margin, and at least a second portion on the opposite side of said at least one line of weakness from said upper margin (Drake's longitudinal line of weakness in the form of perforations 5 that extend parallel to the spine part 3); and wherein said pattern of repositionable adhesive comprises a first pattern (the portion of Drake's strip 8 of low tack adhesive that

remains with the pad when the sheets 1 are removed from the pad); and further comprising at least a second pattern of repositionable adhesive on said bottom face of top sheet adjacent a said line of weakness on the opposite side thereof from said upper margin, said second pattern substantially parallel to said upper margin (the portion of Drake's strip 8 of low tack adhesive that remains with the sheets 1 when the sheets 1 are removed from the pad).

In like manner, claim 3 is readable on Drake as follows. A record pad as recited in claim 2 wherein said patterns of repositionable adhesive are substantially continuous linear strips of adhesive (both portions of Drake's strip 8 are substantially continuous linear strips of adhesive).

In similar manner, claim 4 is readable on Drake as follows. A record pad as recited in claim 3 wherein said top sheet upper and lower margins are shorter than said top sheet side margins (the top upper and lower margins of Drake's sheet portion 1a are shorter than its side margins).

In like manner, claim 6 is readable on Drake as follows. A record pad as recited in claim 4 wherein said securing edge margin of each sheet set is adjacent said upper margin of each of said top sheets and said record sheets (the securing edge margin (Drake's spine part 3) of each of Drake's sheet set is adjacent the upper margin of each of the removable sheets 1 and the record sheets 2).

In similar manner, claim 7 is readable on Drake as follows. A record pad as recited in claim 1 further comprising a mechanical attachment adjacent said securing edge margin connecting all of said sheet sets together (Drake's helical wire 4), and a through cut line between said top sheet and said mechanical attachment (Drake's line of weakness 5 can be either a cut line or perforations as taught in column 3, lines 26-30).

In like manner, claim 10 is readable on Drake as follows. A record pad as recited in claim 1 wherein said securing edge margin of each sheet set is adjacent said upper margin of each

of said top sheets and said record sheets (the securing edge margin (Drake's spine part 3) of each sheet set is adjacent the upper margin of each of the removable sheets 1 and the record sheets 2).

In similar manner, claim 12 is readable on Drake as follows. A record pad as recited in claim 1 further comprising securing means for securing said top and record sheets at said securing edge margin thereof (Drake's helical wire 4); and wherein said securing edge margin of each sheet set is adjacent said upper margin of each of said top sheets and said record sheets (the securing edge margin (Drake's spine part 3) of each sheet set is adjacent the upper margin of each of the removable sheets 1 and the record sheets 2); and further comprising a line of weakness between each of said top sheets and said securing means (Drake's longitudinal line of weakness in the form of perforations 5 that extend parallel to the spine part 3), said pattern of repositional adhesive adjacent said line of weakness (Drake's strip 8 of adhesive is adjacent the perforations 5).

Claim 16 is readable on Drake in much the same manner as claim 2 is readable on Drake. Claim 20 is readable on Drake in much the same manner as claim 12 is readable on Drake.

Thus, the argument presented by the appellant does not convince us that the subject matter of claims 1-4, 6, 7, 10, 12, 16 and 20 is novel. Accordingly, the decision of the examiner to reject claims 1-4, 6, 7, 10, 12, 16 and 20 under 35 U.S.C.

§ 102(b) is affirmed.

The obviousness rejection over Drake

We sustain the rejection of claims 1-4, 6, 7, 10, 12, 16 and 20 under 35 U.S.C. § 103 as being unpatentable over Drake, but not the rejection of claims 5, 9, 11 and 19.

As noted above, Drake does teach all the limitations of claims 1-4, 6, 7, 10, 12, 16 and 20. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529,

220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, we sustain the examiner's rejection of appealed claims 1-4, 6, 7, 10, 12, 16 and 20 under 35 U.S.C. § 103.

As to claims 9 and 19, the examiner has not established that the limitations of their respective parent claims (i.e., claims 8 and 17) would have been obvious at the time the invention was made to a person having ordinary skill in the art. The examiner has not applied any evidence sufficient to establish a prima facie case of obviousness³ with respect to claims 9 and 19.

³ In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

As to claims 5 and 11, the examiner has not cited any evidence⁴ as to why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the securing means at the side margin while having the adhesive adjacent to the upper margin.⁵ Absent such evidence, we conclude that the only suggestion for modifying

⁴ Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard Inc. v. M3 Sys., Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 1804 (1999). A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." E.g., McElmurry v. Arkansas Power & Light Co., 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993); In re Sichert, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

⁵ In this regard, if an artisan wanted the helical wire 4 of Drake to be on the side edge of the pad, the artisan would have rotated the pad from its second "normal use" position to its first "normal use" position.

Drake in the manner proposed by the examiner to meet the limitations of claims 5 and 11 stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 5, 9, 11 and 19 under 35 U.S.C. § 103 is reversed.

The obviousness rejection over Drake and Johnsen

We sustain the rejection of claims 12-14 and 18 under 35 U.S.C. § 103 as being unpatentable over Drake in view of Johnsen, but not the rejection of claims 8 and 17.

In this rejection (answer, p. 4), the examiner determined that it would have been obvious to one of ordinary skill in the art "to utilize Johnsen's teaching of providing adhesive spaced from the upper edge in the invention of Drake."

As to claims 8 and 17, the examiner has not established that the limitations of these claims⁶ would have been obvious at the time the invention was made to a person having ordinary skill in the art. The examiner has not applied any evidence sufficient to establish a prima facie case of obviousness with respect to claims 8 and 17.

As to claims 12-14 and 18, we conclude that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to apply the teaching of Johnsen (column 9, lines 2-6) of providing the tear lines slightly above the respective adhesive band to Drake's pad so that Drake's adhesive is spaced from the line of weakness to protect the adhesive as taught by Johnsen. Furthermore, we agree with the examiner (answer, p. 4) that the claimed

⁶ Claim 8 reads as follows: A record pad as recited in claim 2 wherein two lines of weakness are provided in said top sheets substantially parallel to said upper margin dividing said top sheet into three portions.

Claim 17 reads as follows: A record pad as recited in claim 16 wherein two lines [of weakness] are provided in said top sheets substantially parallel to said upper margin dividing said top sheet into three portions.

distances set forth in claims 13, 14 and 18 "would have been obvious based on routine experimentation for optimization."

This accords with the general rule that discovery of an optimum value of a result effective variable (in this case, the optimum distance) is ordinarily within the skill of the art. See In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980) and In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). As stated in In re Huang, 100 F.3d 135, 139, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996):

This court and its predecessors have long held, however, that even though applicant's modification results in great improvement and utility over the prior art, it may still not be patentable if the modification was within the capabilities of one skilled in the art, unless the claimed ranges "produce a new and unexpected result which is different in kind and not merely in degree from the results of the prior art."

Additionally, as stated in In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990):

The law is replete with cases in which the difference between the claimed invention and the prior art is some range or other variable within the claims. . . . These cases have consistently held that in such a situation, the applicant must show that the particular range is *critical*, generally by

showing that the claimed range achieves unexpected results relative to the prior art range [citations omitted].

In the present case, however, the appellants have not even alleged, much less established, that the claimed distance produces unexpected results. Accordingly, the examiner's rejection of claims 12-14 and 18 under 35 U.S.C. § 103 as being unpatentable over Drake in view of Johnsen is sustained.

The obviousness rejection over Drake and Perriman

We will not sustain the rejection of claim 15 under 35 U.S.C. § 103 as being unpatentable over Drake in view of Perriman.

Claim 15 reads as follows: A record pad as recited in claim 1 further comprising a foldable flap connected along a said side edge of said sheet sets and foldable about a fold line parallel to said side edges.

Figure 7 of Perriman shows a record pad 1 associated with a cover 9. However, this cover is foldable along the edge opposite to the securing means which retains the sheets together to form the pad. If the teachings of Perriman were to be combined with Drake it would have the cover fold about the lower margin of Drake's pad, not the side margin as recited by claim 15. Thus, the combination of the applied prior art would not arrive at the claimed invention. Accordingly, the decision of the examiner to reject claim 15 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-4, 6, 7, 10, 12, 16 and 20 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claims 9 and 19 under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claims 1-4, 6, 7, 10, 12-14, 16, 18 and 20 under 35 U.S.C. § 103 is affirmed; and the decision of the examiner to reject claims 5, 8, 9, 11, 15, 17 and 19 under 35 U.S.C. § 103 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

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